

***United States Court of Appeals
for the Second Circuit***



**PETITION FOR
REHEARING**

76-7563

United States Court of Appeals

FOR THE SECOND CIRCUIT

DAVID COHN,

Plaintiff-Appellant,

against

COLECO INDUSTRIES, INC.,

Defendant-Appellee.

APPEAL FROM AN ORDER AND JUDGMENT OF THE UNITED STATES
DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

PLAINTIFF-APPELLANT'S PETITION FOR REHEARING

KENNETH E. MACKLIN
180 South Broadway
White Plains, N.Y. 10605
(914) 949-6550

and

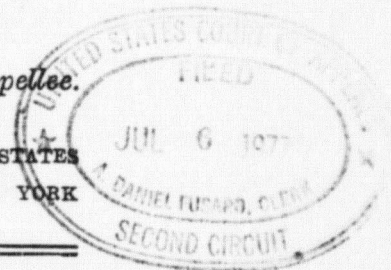
KENYON & KENYON REILLY
CARR & CHAPIN
PAUL H. HELLER
59 Maiden Lane
New York, New York 10038
(212) 425-7200

Attorneys for Appellant
David Cohn

July 1, 1977

Dated: ~~June 24, 1977~~

At: New York, New York



IN THE
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 76-7563

DAVID COHN,
Plaintiff-Appellant,

v.

COLECO INDUSTRIES, INC.,
Defendant-Appellee.

PLAINTIFF-APPELLANT'S PETITION FOR REHEARING

David Cohn, plaintiff-appellant, respectfully prays that this Honorable Court reconsider its decision issued on June 3, 1977, reverse the final Order and Summary Judgment of the Honorable Judge Whitman Knapp, and order that the Complaint be reinstated and that the action be remanded for trial on the merits.

The plaintiff is seeking this rehearing for the following reasons:

- (1) Because Judge Knapp's order did not contain any findings of fact, the plaintiff did not have an opportunity to present arguments on the findings of fact and conclusions of law which were first made known to the plaintiff in this Court's opinion of June 3, 1977.

- (2) There is believed to be an inconsistency in the opinion due to the Court's not having the benefit of findings of fact from the District Court and consequently adequate briefs and argument on the matter which forms the basis for its decision.

The points of law or fact underlying this petition which are believed to have been overlooked or misapprehended in the Court's opinion are:

- (A) Findings of fact were made for the first time by this Court in its opinion. It is respectfully submitted that making findings of fact is not within the Court's mandate of appellate review, but rather within the mandate of the District Court.
- (B) The springs of the Coleco "Bowl-A-Matic 300" are equivalents of the Cohn patent springs. The Coleco springs function like the Cohn springs rather than the Igou springs of the prior art.
- (C) The Doctrine of File Wrapper Estoppel is not applicable.
- (D) (i) The file wrapper of a patent should be examined only to determine the question of estoppel through rejected claims, and not to consider the arguments of the applicant and the examiner.
- (ii) In any event, the Patent Office did not rely on statements by Cohn's attorney. Consequently, there can be no file wrapper estoppel because reliance is a necessary element of estoppel.

A. FINDINGS OF FACT SHOULD BE MADE BY DISTRICT COURT
AND NOT BY COURT OF APPEALS

The plaintiff respectfully submits that this Court should have vacated the judgment and remanded the action for appropriate findings of fact to be made. United Shoe Mach. Corp. v. Kamborian 160 F 2d 461 (1st Cir., 1947), cert. denied 335 US 885 (1948). In the absence of findings of fact, the appellate court should not make them in a trial de novo, but should remand the case. See Moore's Federal Practice (2d Ed.), Para. 52.06 (2) (2d Ed.), page 2718 et seq., particularly footnote 1 and the cases therein.

It is conceivable that findings of fact from the District Court might have indicated the presence of a fact issue or other reason for summary judgment to be reversed. With findings of fact the plaintiff would have been aided in properly presenting his appeal, and this Court would have been aided in deciding the appeal. As it stands now, the plaintiff is first able to address the findings of fact and reason for the decision at the stage of a Petition for Rehearing. All doubts should be resolved in favor of the plaintiff in view of the drastic nature of summary judgment.

In view of the foregoing comments, the plaintiff requests that the Petition for Rehearing be heard and in view of the following comments that the judgment be reversed and the action be remanded for trial on the merits.

B. COLECO SPRINGS ARE EQUIVALENTS OF SPRINGS IN COHN PATENT

In the Coleco game the principle of operation is identical to that of Cohn's patent. To reset the pins in both games,

one must do the two things indicated in the Court's opinion. First, lower the pins to the base plate in triangular formation to magnetically attract the pins to the base. Second, stretch (place under tension) the elastic strings attached to the pins so that the elastic strings can remove the struck pins from the playing surface.

Both games accomplish the first task in the same manner, i.e., they use a guide plate with ten holes in a triangular pattern. It was this element, when introduced into the claims of the Cohn application, which caused the Examiner to allow the application. Despite the necessity of the guide plate in the Coleco game, the guide plate is not mentioned in the claims of the Coleco patent (Appendix, pages 155 to 157). Probably because of its absence from the claims, the Examiner never cited the Cohn patent against the Coleco application which matured into U.S. Patent 3,866,691 (Appendix, page 146). Despite Coleco's knowledge of Cohn's patent prior to filing its application (Coleco's answer to Cohn's Interrogatory No. 30, Record, Docket Entry No. 8, page 11), Coleco did not bring Cohn's patent to the attention of the Patent Office in accordance with the Office's policy of encouraging voluntary citation of prior art by applicants. The Patent Office has issued two notices on the policy which have appeared in the Official Gazette of the Patent Office. One notice is dated April 13, 1967 (846 O.G. 688), prior to filing of the Freeman application which matured into Coleco's patent, and another notice was issued by the Patent Office

on August 12, 1974 (926 O.G. 2-3), during pendency of the application. Copies of both notices as reprinted in Horwitz, Patent Office Rules and Practice (Vol. 2, p. 38 and Vol. 3, pp. 2319-2321, respectively) are appended for the Court's convenience.

The second task is accomplished in both the Cohn patent and in the Coleco game by the use of springs. The springs in both the Cohn patent and the Coleco game also stabilize the tension of the elastic strings, particularly for pins remaining on the playing surface when only some pins are struck. The springs of the Cohn patent and the Coleco game are more alike in operation to each other than they are to the springs of Igou. In the first place, the guide plates in the Cohn patent and the Coleco game are immobile in contrast to the pin holder of the Igou patent, which is mobile. The springs in the Igou patent operate on the pin holder to pull it up out of the playing area. In the Cohn patent and the Coleco game, the guide plates are already fixed at a distance above the playing surface.

In all three games, the springs have a short and a long position. In Igou the springs are long, or stretched, when the pin holder is lowered to the surface of the alley to reset the separate pins. (The springs in Igou cannot place the pins under tension because the pins are not even tethered to the spring-biased mechanism.) However, in both the Cohn patent and the Coleco game, the springs are in their short position when they are resetting the pins on the base plates

of the games. In both the Cohn patent and Coleco game, the springs are in their long position when the games are set for play and the pins are placed under tension by their elastic strings.

In both the Cohn patent and in the Coleco game, removal of struck pins from the playing surface is automatic. In Igou, removal of struck pins from the playing surface is a manual operation, each one being separately picked up.

In the best mode of the Cohn patent and in the Coleco game, the springs normally urge the support member upward or away from the base. In the best mode of the Cohn patent, this returns the support to its original position after its manual depression puts the pins in contact with the alley. In its spring-aided return to its normal position, the support member puts the pin strings under tension. In the Coleco game, tension is imparted to the pin strings by the action of the spring bar being moved down. However, because of the turns in the pin strings, this is equivalent to an up movement in the best mode of the Cohn patent as may be seen when the downward turns in the Coleco pin strings are turned upward on the model of Cohn's Exhibit B, thereby approximating the in-line action of the best mode of the Cohn patent. In the Coleco game, the natural urge of the springs is used to reset the pins.

It can be seen then that there are two positions for the support members of the Coleco game and the best mode of the Cohn patent. One position places the pins on the play-

ing surface where they are magnetically attracted. The other position places the elastic strings attached to the pins under sufficient tension so that struck pins will be removed from the playing surface. The supporting members in both games are spring-urged to return and be retained above the base plates of the games. The minor difference is that the normal urging of the springs results in placement of the pins in the Coleco game, and in the best mode of the Cohn patent it places the strings under tension. A manual operation is required to put tension on the pin strings in the Coleco game and to place the pins on the base in the best mode of the Cohn patent. It should be noted that in his patent, Cohn recognized that variations and modifications could be made within the spirit and scope of his invention (Appendix, page 44, Col. 5, lines 5 to 7).

It will be seen that the minor difference is the mere reversal in the effect of the spring-urging, but the two steps in the game operation as found by this Court are present in the Cohn patent and in the Coleco game. In the Cohn patent, pin placement requires external action, and tension is created during the natural return. In the "Bowl-A-Matic 300," pin placement is via natural urging, and tension is created by externally applied movement of the spring bar. This difference is de minimus under the test of substantial identity of function, mode and result as set forth in Graver Tank & Manufacturing Co. v. Linde Air Products Co., 339 U.S. 605, (1950), 85 USPQ 330-331:

(C)ourts have ... recognized that to permit imitation of a patented invention which does not copy every little detail would be to convert the protection of a patent grant into a hollow and useless thing. Such a limitation would leave room for - indeed encourage - the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the reach of law. One who seeks to pirate an invention ... may be expected to introduce minor variations to conceal and shelter piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention....

* * * *

"To temper unsparing logic and prevent an infringer from stealing the benefit of an invention" a patentee may invoke this doctrine to proceed against the producer of a device "if it performs substantially the same function in substantially the same way to obtain the same result." ... The theory on which it is founded is that "if two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form, or shape." ... The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results....

* * * *

Equivalence, in patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

A finding of equivalence is a determination of fact. ... It is to be decided by the trial court....

The plaintiff is ready to produce evidence, particularly expert testimony by Mr. Slinger, on this matter if and when this Court grants plaintiff's petition.

Cohn filed his application in 1958. A review of the prior art cited against his application shows that over a span of years from 1918 no one developed a toy bowling game or pin setting device like his. It should be noted in reviewing the list of 16 references cited in the file of the Cohn patent that 6 were cited merely to show that under Patent Office classification there were 3 inventions claimed in the application, and therefore restriction to only one was required. The tethered pin setting mechanism was elected. Of the remaining references, only Lloyd (1940) and Igou (1933) were substantially relied on by the examiner. Hedenskoog (1944) was relied on to a lesser extent. In view of the time lapse between the prior art and Cohn's invention, it cannot really be stated to be a narrow invention.

In addition, Cohn's game was commercially successful. Now Coleco with the accused device has had total sales estimated in the millions of dollars generated by extensive television advertising. Certainly, the Cohn patent must be accorded a range of equivalents, and Judge Knapp indeed recognizes this in his opinion.

Note the quotation on the doctrine of equivalents from Judge Learned Hand in Capri Jewelry v. Hattie Carnegie Jewelry Enterprises 539 F 2d 846, 851 (2 Cir., 1976):

All patents are entitled to its benefit to an extent, measured on the one hand by their contribution to the art, and on the other by the degree to which it is necessary to depart from the meaning to reach a just result.

C. DOCTRINE OF FILE WRAPPER ESTOPPEL NOT APPLICABLE

In the Official Action of January 7, 1960, the Examiner rejected the claims on several grounds, Lloyd as showing magnets and Hedenskoog guide means and compression springs (Appendix, page 69). In response, original claim 4 was cancelled without prejudice, and new claim 17 was inserted. This claim recited a "spring-urged supporting member" and characterized it as "automatically returning and being retained in normal spaced relation above the base plate." (Amendment of July 6, 1960, Appendix, page 73).

In the next rejection, dated October 26, 1960 (Appendix, page 80), the Examiner took the position that claim 17 "reads directly on Lloyd," as his supporting member was "spring-urged" (laterally) "in its stationary position." Further, the Examiner stated, "No patentable consideration is accorded the functional statements in the last seven lines of the claim." Hedenskoog was cited to show the obviousness of a "spring-urged" support member. Claim 17 was also rejected as unpatentable over Lloyd in view of Igou. The Examiner stated, "To cause the pin setting support means of Lloyd to be spring biased in upward direction would be obvious in view of Igou."

In a response thereto, filed April 18, 1961 (Appendix, page 83), Claim 17 was amended to include the element "spring

means normally urging said supporting member away from said base plate." This amendment was taken from the best mode described in the Cohn application. The applicant's attorney stated, "In the patent to Lloyd the only spring means ... exert a pressure laterally against the locator plate to hold it in its raised position."

The final rejection of April 21, 1961 (Appendix, page 87) withdrew Hedenskoog and applied Lloyd in view of Igou against all the claims. The proposed amendment of April 18, 1961 was "not entered because it does not place the case in condition for allowance." Claim 17, "if amended as proposed, would be considered unpatentable over Lloyd in view of Igou for reasons of record." Following an interview, claim 17 was rewritten as claim 18 in an amendment filed April 28, 1961 (Appendix, page 89), wherein the guide plate was included. This was the element which caused the examiner to allow the application. The fixed guide plate differentiated over the Lloyd and Igou patents, which had movable pin locator plates.

It is important to note that this is not a case where the specific Coleco means were excluded from the claims. Rather, a single species from the best mode described in the specification was substituted for a generic term ("spring-urged") to avoid having the claims read on means (Lloyd) unlike Coleco's. There should be no estoppel barring this action with respect to that amendment, and claim 1 is entitled to some range of equivalents.

In the quotation from Exhibit Supply Co. v. Ace Patents Corp. 315 U.S. 136 (1942), the Court has chosen a statement of the law on file wrapper estoppel by the Supreme Court which is believed to be incorrect. It should be recalled that the same Court brought us another unfortunate phrase, "flash of genius," which caused great confusion. See Graham v. John Deere Co. 383 US 1, 15 (1966), particularly footnote 7, in which that controversial phrase is stated to be "but a rhetorical embellishment of language." "More matter with less art" would have been better in that phrase, and it is believed to be true in the quotation from the Exhibit case as well. The language about the "difference" is believed to be overblown and suggestive of mathematical exactness. Unfortunately, that is not the correct way to interpret file wrapper estoppel. The better way is the later statement by the Supreme Court in the Graham case:

Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent. Id. at 33.

There the examiner imposed limitations, Id. at 34. No such limitations were imposed in the Cohn application. The "estoppel" situation presented here is one wherein a broad generic claim ("spring-urged") was stated to read on a prior art reference (Lloyd). There would be a classic estoppel were Coleco's game to employ this prior art "spring" means,

as this specific means was clearly disclaimed. Coleco's device, however, is more similar to Cohn's patent than to the prior art device. See Southern Textile Machinery Co. v. United Hosiery Mills Corp. 33 F.2d 862, 866 (6th Cir. 1929) and other cases cited on pages 13 and 14 of Appellant's Brief.

An ultimate fact issue as to equivalency of Cohn's specific means and Coleco's would remain. All that can be stated with absolute certainty is that the claims do not cover all spring means nor the means shown in the Lloyd patent. These latter means are unlike Coleco's, and Coleco was not therefore specifically excluded from the Cohn patent. The mode (springs) and result (pin set) are substantially identical. The function of the springs, while reversed in Coleco, is also "similar" to the Cohn patent.

It is important to note that the foregoing discussion applies particularly to claim 1 of the patent. More importantly, it should be noted that claim 3 of the patent went through prosecution unamended in substance. Consequently, there can be no question of file wrapper estoppel with respect to it. It describes a "spring means yieldably holding the said reset part in a raised position." It either covers the Coleco springs literally or the doctrine of equivalents is applicable to it.

D. APPLICANT'S ARGUMENTS SHOULD NOT BE CONSIDERED
ON ISSUE OF FILE WRAPPER ESTOPPEL

(i) In its opinion, this Court mentions arguments made during the prosecution of the Cohn application concerning tension springs in Igou's device used to pull up his pin holder and compression springs in Cohn's best mode which push up his reset plate.

In A. G. Spalding & Bros. v. John Wanamaker 256 F. 530 533-534 (2d Cir. 1919), Judge Learned Hand stated:

We take this occasion, however, once more to say that in the consideration of a file wrapper we do not look at the arguments of the applicant to the examiner. We wish it to be understood that, as we conceive the purpose for which the file wrapper can be examined, it covers simply the question of estoppels through rejected claims. The whole doctrine is somewhat anomalous at best, since it involves looking at preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions. The practice, however, is too well settled for us to disturb, and we have no intention of casting any doubt upon it. This court, nevertheless, has twice already disapproved the practice of bringing into that interpretation the arguments of an applicant.

(ii) Collateral estoppel is a subclass of estoppel, and reliance is an essential element of any estoppel. In the Patent Office's granting of the patent to Cohn, there was no reliance by the Patent Office on the statements about springs which form the basis of this Court's decision. In Capri Jewelry v. Hattie Carnegie Jewelry Enterprises, Ltd., 539 F.2d 846, 851, James' patent solicitors succeeded in convincing the Patent Office that he had overcome the charge of obviousness in light of Hodson based on a critical limitation

in the claim. Here Cohn's attorneys never convinced the Patent Office with their statements. It is important to note that in the Capri case, the applicant specifically cancelled and abandoned claim 9 which would have specifically covered the accused product, and acquiesced in the examiner's position by retaining a claim which did not cover the accused product. That is not the situation here.

It is submitted that material issues of fact have been shown to exist. Therefore, it is respectfully requested that this Petition for Rehearing be granted. If the Court has any hesitancy about reversing and remanding, an opportunity for reargument would be appreciated. Such an opportunity would be equitable in view of the history of this action.

Respectfully submitted,

Kenneth E. Macklin
180 South Broadway
White Plains, New York 10605
(914) 949-6550
Attorney for Plaintiff-Appellant

OF COUNSEL

Paul H. Heller
KENYON & KENYON REILLY CARR & CHAPIN
59 Maiden Lane
New York, New York 10038
(212) 425-7200

art reference is not affected by the foreign filing date to which the patentee may be entitled under 35 U.S.C. 119. *In re Hilmer*, 833 O.G. 13, 149 USPQ 480 (CCPA (1966)); *Lilly et al. v. Brenner*, 153 USPQ 95 (C.A.D.C. 1967). The reference patent is effective as of the date the application for it was filed in the United States (35 U.S.C. 102(e) and 103). *Hazeltine Research, Inc. et al. v. Brenner*, 824 O.G. 8 (U.S. Supreme Court 1965).

846 O.G. 688
858 O.G. 13

April 13, 1967

**Policy re: Voluntary Citation of Prior Art
by Applicants**

Effective immediately, the following policy is being adopted in the hope of encouraging more frequent and meaningful citation of prior art by applicants and their attorneys on a voluntary basis.

Prior art cited by applicants or their attorneys within thirty days of the filing of a patent application, or prior to the first Office action, whichever is later, will be fully considered by the Examiner, will be part of the official record, and will be included in the list of references cited in the patented file and in the printed patent provided the applicant:

(a) Limits the number of references cited to not more than five separate items, unless a satisfactory explanation is given as to why more than five citations are necessary, and submits one copy of each of the references; and

(b) Submits a detailed discussion of the references, which discussion points out, with the particularity required by Rule 111(b) and (c), how the claimed subject matter is distinguishable over the references.

References cited by applicants or attorneys under the "special" examining procedure announced on March 2, 1965, and published in 812 O.G. 953 will also be included in the list of references cited in the patented file and printed patent.

Prior art cited by applicants and attorneys under the practice set forth in the notices published in 797 O.G. 733; 802 O.G. 601; 804 O.G. 1 and 805 O.G. 294 will no longer be listed in the printed patent.

is itself incomplete through the failure to record the substance of interviews. In addition to the requirement of Rule 2, Rule 133(b) is specific that

"In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in Rules 111, 135."

Applicants and their attorneys or agents are responsible for compliance with the requirement for a complete written statement except in those situations in which it is agreed that the examiner will issue an Office action upon the application without further written response on behalf of applicant. In those situations, the examiner will make the substance of the interview of record in the Office action. The examiner may also complete the record of an interview if significant matters are inadvertently omitted from a written statement filed on behalf of applicant.

Noncompliance on behalf of applicant with the above noted requirement for a complete written statement when filing a response, will result in the applicant being given one month from the date of the notifying letter or the remainder of any period for response, whichever is longer, to complete the response and thereby avoid abandonment of the application (Rule 135(c)). Except for the paragraphs under the heading "EXAMINER TO CHECK FOR ACCURACY" the substance of this notice supersedes Section 713.04 of the Manual of Patent Examining Procedure.

WILLIAM FELDMAN,
Deputy Assistant Commissioner for Patents.

926 O.G. 2-3

August 12, 1974

Citation of Prior Art by Applicants

The purpose of this notice is to set forth positive guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the Patent Office. Such citations of relevant art are welcomed and are encouraged. In order that they may be most effectively considered by the examiner, however, with as little disruption of the regular examination process as possible, it is requested that they be submitted in accordance with the following guidelines.

(1) Citations should be submitted within three months after the application filing date if possible. Any citation made after the first action on the merits (if this occurs more than three months after filing) should be accompanied by an explanation of why it was not earlier presented. This may take

the form of a statement that it was made as soon as the art or other material was discovered, or as soon as its pertinency was appreciated, indicating the date of discovery of the cited material or its pertinency.

(2) Full text copies of the pertinent portions of all such prior art citations or other material relevant to patentability of the claimed invention should be supplied, whether the citation is made in a separate paper or in the specification of the application. This will be unnecessary in the case of pending or abandoned United States applications (e.g. Defensive Publications). In the case of publications, a copy of the title page, its copyright notice or other indication of a publication date, and copies of the entire pages which contain the text of the relevant material will be sufficient.

While patent copies are, of course, available in the Patent Office, failure of the applicant to include copies of the cited art means that the examiner must interrupt his examination until copies can be ordered and received. Since the person making the citation will have copies in hand, an overall saving in time and more expeditious examination will result if copies are supplied with the citation.

(3) If the reference is not in English, a translation of its pertinent portions should be included.

(4) Accompanying each citation should be an indication of its pertinency to the claimed subject matter, together with any reasons applicant may wish to point out why the claims are considered to be patentable over the cited material.

All citations of prior art or other material submitted in accordance with the above guidelines and submitted before all claims have been indicated as allowable will be fully considered by the examiner.

While the Patent Office will not knowingly ignore any prior art which might anticipate or suggest the claimed invention, no assurance can be given that cited art or other material not submitted in accordance with these guidelines will be considered by the examiner. Consequently, any patent issuing on the application in question would not be expected to be accorded the usual presumption of validity with respect to such cited art or material.

After the claims have been indicated as allowable by the examiner, e.g., by the mailing of an *Ex parte* Quayle action, a notice of allowability (POL-327), an examiner's amendment (POL-37), or a Notice of Allowance, any citations submitted will be placed in the file. Since prosecution has ended, however, such submissions will not ordinarily be considered by the examiner unless the citation is accompanied by:

- (a) A proposed amendment cancelling or further restricting at least one independent claim and narrowing the scope of protection sought;
- (b) A timely affidavit under Rule 131 with respect to the material cited; or
- (c) A statement by the applicant or his attorney or agent that, in the judgment of the person making the statement, the prior art or other material cited raises

a serious question as to the patentability of the claimed subject matter.

If the material is submitted after the base issue fee has been paid, it must also be accompanied by a petition under Rule 183 (37 CFR 1.183) requesting a waiver of Rule 312 (37 CFR 1.312). Such petition, if granted, would result in review of the art by the examiner and possible entry of the amendment.

Submitted citations will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing pertinent prior art of which they may be aware, whether or not such art is cited by the applicant. Nothing in this notice is intended to relieve applicants of any responsibility they may have to cite known prior art to the Patent Office.

If the specification or a separate paper filed in the application contains citations relating to background material, applicant has the responsibility of determining whether or not such material is sufficiently relevant to the claimed invention that full compliance with these guidelines is necessary.

Prior art submitted by applicant in the manner provided herein will not be supplied with an Office action, but will be listed on the Form PO-892, "Notice of References Cited," along with other prior art relied upon by the examiner during the examination. Only that prior art listed by the examiner on Form PO-892, will be printed on the patent. However, the complete listing of applicant's citations will be in the application file and will be available for inspection by the public after issuance of the patent.

Citations of prior art may be placed of record in the patented file after the grant of the patent at the request of the patentee (see Section 100(d) of Title 35, United States Code, for definition of patentee). Any such submissions by the patentee will be placed in the patented file without comment by the Patent Office. Citations submitted to the Patent Office by third parties will not be placed in the record of a patented file unless the party submitting the art certifies that he has sent the owner of record copies of the cited art and of his letter transmitting it to the Patent Office.

Prior Notices

This notice supersedes the notices of:

December 10, 1963 (797 O.G. 733)

April 24, 1964 (802 O.G. 601)

June 22, 1964 (804 O.G. 1)

July 24, 1964 (805 O.G. 294)

April 13, 1967 (837 O.G. 1032)

WILLIAM FELDMAN,

Aug. 12, 1974. *Deputy Assistant Commissioner for Patents.*

KENNETH E. MACKLIN
ATTORNEY AT LAW
180 SOUTH BROADWAY
WHITE PLAINS, NEW YORK 10605
TELEPHONE (914) 949-6550

July 1, 1977

Clerk, United States Court of Appeals
Second Circuit
Foley Square
New York, New York 10007

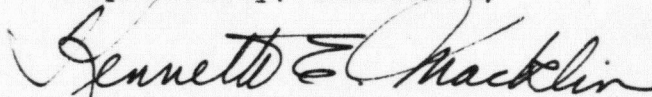
David Cohn v. Coleco Industries, Inc.
Appeal No. 76-7563

Dear Sir:

Enclosed are ten (10) copies of Plaintiff-Appellant's
Petition for Rehearing.

By copy of this letter, the Petition is being served by
first class mail on both counsel for the Appellee.

Respectfully, submitted,



Kenneth E. Macklin
Attorney for Appellant

KEM:eh
encs.

cc: Peter L. Costas, Esq.
S. L. Kantor, Esq.
P. H. Heller, Esq.